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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Great Northern Enterprises, LLC

Serial No. 78071887

Michael M. Krieger, Esq. for Great Northern Enterprises, LLC.

Josette M. Beverly, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Hohein, Hairston and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Great Northern Enterprises, LLC has filed an application to register the phrase "INDUSTRY PROCESS RE-ENGINEERING" as a mark for "computer software for business management, namely, for managing and coordinating risk, time and financial parameters in multi-component business analysis and project development."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the

¹ Ser. No. 78071887, filed on July 2, 2001, which is based upon an allegation of a bona fide intention to use such phrase in commerce.

ground that, when used in connection with applicant's goods, the mark "INDUSTRY PROCESS RE-ENGINEERING" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

It is well settled that a mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a mark describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the mark describes a significant attribute or idea about them. Moreover, whether a mark is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is

not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Applicant, noting that the goods in its application are identified as "computer software for business management, namely, for managing and coordinating risk, time and financial parameters in multi-component business analysis and project development," argues in its initial brief that because such software "is described as nothing more than for managing and analyzing standard elements [of] a business and its projects," it is not merely "described on the grand scale that is implicit in the phrase 'industry process re-engineering,'" which is "something

that conveys breadth, scope and transformation." Applicant urges that its mark thus "partakes of ... hyperbole and incongruity" since "industry or business process re-engineering is something of a grand scale, not simply a software product." Applicant also asserts that while the Examining Attorney has cited a dictionary definition showing that "industry" is a synonym for "business," such evidence does not establish "why 'business' and 'industry' yield equivalent commercial impressions in the context of the Mark." Finally, applicant contends that "[b]y dissecting the Mark into Industry + {Process Re-Engineering}, the examining attorney fails to give evidence why it should not be [treated as] {Industry Process} + Re-Engineering." According to applicant, "[w]hile this may seem [to be] a distinction without a difference to us as lawyers, that is not the case in the IT and management worlds" since the evidence it has furnished "discusses 'industry processes' and their management, not 'process re-engineering'" of an industry.

In support of its assertions, applicant has submitted with its initial brief the declaration, with exhibits, of Richard Schramm, who describes himself as the "CEO of the Applicant" and "a professional in the information technology industry for more than 18 years."² Mr. Schramm states, among other things, that

² Recognizing that the submission thereof at such juncture is untimely under Trademark Rule 2.142(d), applicant requests in its initial brief that "the Board accept the evidence introduced herein on appeal." Inasmuch as the Examining Attorney states in her initial brief that she "does not object to the introduction of this untimely evidence, since it further supports her position that the proposed mark is descriptive," applicant's request is approved and the evidence submitted with its initial brief has been given consideration.

from 1985 through October 1990, his "principal employment was for NYNEX, Pac-Tel Infosystems, and Attachmate"; that from October 1990 to October 1997, he "went to work for Microsoft"; that he consequently "can speak with authority about the language of the IT world, its significance and usage"; and that it was such knowledge which led him, as applicant's CEO, "to adopt a mark for the company's business software that is in fact suggestive rather than descriptive of the product."

Having been "at various times pure systems engineer and marketing consultant," Mr. Schramm further notes in his declaration that in the course of such work he has probably reviewed upwards of "thousands of business requirements [which are] often reflecting specific business processes that either existed and were to be improved or desired and to be initially automated"; that, "[a]s such[,] many were to be 're-engineered'"; that when "projects [which] were closely aligned to the vertical integration of companies and the associated business processes" "took a new tack on execution of business processes, we would refer to them as 'business process re-engineering'"; that the phrase "Business Process Re-engineering (BPR)," with or without a hyphen, "emerged [as] a popular buzz-word of the '90s" which was "widely picked up by consultants, business schools, and the like"; and that "[t]his wide usage is reflected in a current Google search for BPR which yields 57,000 hits (72,000 hits without a hyphen."

With respect to the phrase "Industry Process Re-Engineering (IPR)," however, Mr. Schramm asserts that such is

"[a] phrase of effectively insignificant formal use in the IT/business word," since "IPR yields a scant 34 Google hits (33 without hyphen and these reduce to a handful when pseudo-hits of the form '*... about the concrete industry. Process re-engineering may take ...*' and duplicative hits are removed"; that the phrases "business process re-engineering" and "industry process re-engineering" are not equivalent since "[n]one of the few IPR uses support its perception as equivalent to BPR"; that "IPR has no meaning except as defined momentarily for a specific discussion by the few authors who have used it"; that, as the person who selected applicant's mark, "[t]he absence of any significant use or consistent meaning for 'Industrial [sic] Process Re-Engineering' was a major reason for its choice"; that while "BPR has wide connotations and might be descriptive of certain software, IPR is really little more than an assemblage of 'buzz-words' designed to suggest in general terms an ambiance ... [and] to elicit confidence in the buyer by connoting qualities such as universality and strength without anything specific about the software"; and that given "the phrase's paucity of directly inferable meaning," it thus is only suggestive of applicant's goods and not merely descriptive thereof.

The Examining Attorney, citing a definition from The American Heritage Dictionary of the English Language (3d ed. 1992) along with several excerpts from articles retrieved from searches of the "NEXIS" database, argues in her initial brief that, on the other hand (footnote omitted):

In its entirety, the proposed mark,
INDUSTRY PROCESS RE-ENGINEERING, is merely

descriptive of the applicant's goods, namely, computer software for business management, namely, for managing and coordinating risk, time and financial parameters in multi-component business analysis and project development. As indicated in the final office action, the term "industry" is defined as "2. A specific branch of manufacture and trade: *the textile industry*. See synonyms at business." The term "industry" is synonymous with the term "business". The term "process re-engineering" is a term of art used in the business industry to describe the process of analyzing and managing a business. The articles obtained from LEXIS/NEXIS® show use of the term "industry process re-engineering" and "process re-engineering" in relation to goods and services for the purpose of re-engineering business processes.

The Examining Attorney further maintains, based upon the evidence of record, that when applicant's mark is "considered as a whole in connection with the goods, it does not take imagination, effort, thought or an extra mental step for a prospective customer of the applicant's goods to conclude that the applicant's business management software is for the purpose of managing industry process re-engineering." Applicant's assertion, the Examining Attorney insists, that its software "is described as nothing more than for managing and analyzing standard elements [of] a business and its projects" and, hence, is not merely "described on the grand scale that is implicit in the phrase 'industry process re-engineering'" is belied by "the fact that the applicant's software clearly performs the tasks of industry process re-engineering." The "numerous articles" of record indicate, according to the Examining Attorney, that "the term 'industry process re-engineering' is either synonymous with

'business process re-engineering' or is used to describe a ... broader view of business process re-engineering." Consequently, the Examining Attorney contends, the mark is merely descriptive because "it is clear that the applicant's software ... is a software tool designed to assist in process re-engineering for industries."

As support for her position, the Examining Attorney specifically refers in her initial brief to the following "NEXIS" excerpts:

"'Since most software-vendor products do not meet the diverse requirements of state agencies, many agencies are required to build their systems from the ground up,' Muro said. 'We provide full software life cycle support from business process re-engineering to software design and engineering.'" -- Albuquerque Tribune, March 5, 2001;

"Founded in 1988, Logic Works, Inc., Princeton, is a leading provider of client/server database design and business process re-engineering software solutions for corporate and Internet applications." -- New Jersey Business, July 1997;

"Manufactured by Waldorf, Germany-based SAP AG, the pricey business process re-engineering software is actually a package of more than 850 software applications designed to enable divisions of large corporations to share information more easily." -- Triangle Business Journal (Raleigh, NC), March 28, 1997;

"Electronic Data Systems Corp. said yesterday that it signed a three-year contract to use Network Imaging Corp.'s lView software suite for storage management and business process re-engineering." -- Fort Worth Star Telegram, July 23, 1996;

"Both new and proven management methods touted by book after book today are becoming available. The next generation will see a wealth of real-time support tools for

managers to leverage expert knowledge and effective management. Among tools for managers will be software to assist in process re-engineering, quality improvement, strategic planning, goal tracking and performance appraisals." -- San Francisco Examiner, September 4, 1994;

"Peters has also received two awards to develop a new technique and tools for analyzing the timing and behavior of software systems for the Department of Defense. That project led him to write a program to study work flows, a practice known as business process re-engineering. He is now selling that software to companies such as banks and insurance firms." Puget Sound Business Journal, October 23, 1993; and

"As a spokeswoman, she represents Universal Software, which specializes in process re-engineering and image-document management. That means the company combines hardware and software to get work done more efficiently." -- Crain's Detroit Business, October 11, 1993.

In addition, in her initial brief, she particularly directs attention to the following three Internet excerpts, furnished by applicant with the declaration of Mr. Schramm, as likewise being supportive of her position:

"Although another company may have reengineered its internal business processes and perhaps painfully installed a SAN system to bring efficiencies to the back office, iCommerce is about reengineering outward facing processes--industry process reengineering versus business process reengineering, redefining industry boundaries, inventing new industries." -- <http://pavu.free.fr/iatsu/iatsulettreus.htm> (setting forth portions of what applicant represents is a letter from the CEO of "informative arts technological survey unit");

"Abstract: Industry processes are the trans-corporate business processes required to support the e-business environment. Industry process re-engineering is the re-

engineering of trans-corporate business processes as electronically managed processes." Industry process re-engineering is business process re-engineering on a massively distributed scale. Industry processes will not be restricted to routine workflows that follow a more-or-less fixed path; they will include complex processes for which their future path may be unknown at each stage of their existence. So a management system for industry processes should be both highly scalable and should be able to deal with such complex processes. A multiagent process management system is described that can manage processes of high complexity. This system is built from interacting autonomous components so achieving system scalability." -- (website source not furnished by applicant, but it states that the excerpt is by "John Debenham, University of Technology, Sydney" and is apparently a part of a paper for the 2001 "International Conference on Computational Science" entitled "A Multiagent Architecture Addresses the Complexity of Industry Processes Re-Engineering"); and

"Building e-business process management systems is business process reengineering on a massive scale, it [is] often named industry process reengineering." -- <http://...www-staff.ot.uts.edu.au/~debenham/papers/EC-Web-02.pdf> (setting forth portions of an article represented by applicant to be by "John Debenham, University of Technology, Sydney" and which is entitled "Identifying Arbitrage Opportunities in e-Markets").

We also note, however, that until the submission of her supplemental brief,³ no mention is made by the Examining Attorney of the sole evidence that she initially made of record which relates directly to use of the phrase "industry process re-engineering." Such evidence consists of three "NEXIS" excerpts, of which the following is the most pertinent:

³ The Board permitted the filing of such a brief in response to applicant's submission of two missing pages from its initial brief.

"[The report will] demonstrate an orderly and realistic approach by which any school of business ... can approach reengineering so that the school can move into the 21st century. The report will accomplish this aim by:

....
3. transferring industry process re-engineering knowledge and experience to higher education using a Mission/Vision model
...." -- SAM Advanced Management Journal,
March 22, 1997.

Noting in her supplemental brief that "applicant's business management software is clearly designed for use in connection with an industry," the Examining Attorney urges that the record shows that:

[T]he wording "process re-engineering" is a well-known term of art in the business industry used to describe the process of developing and managing a business. Such process re-engineering would include software products for "managing and coordinating risk, time and financial parameters in multi-component business analysis and project development."

The Examining Attorney therefore concludes that "[p]urchasers of this business management software ... would clearly understand the wording INDUSTRY PROCESS RE-ENGINEERING to describe that the purpose of the applicant's software is to facilitate process re-engineering for their industry."

Applicant, in its reply brief, takes issue with such conclusion and the Examining Attorney's reasoning, reiterating its arguments that "industry process re-engineering" is "a grand concept of which a single software application is but a drop in the bucket"; that the evidence of record shows that the marketplace distinguishes between the well-known phrase "business process re-engineering" and the ambiguous phrase "industry

process re-engineering," such that the latter is not synonymous with the former; and that accordingly its mark is not merely descriptive of its goods.

We are constrained to agree with applicant that, upon consideration of the arguments and evidence presented, the Examining Attorney has failed to demonstrate that the phrase "INDUSTRY PROCESS RE-ENGINEERING" merely describes, with the requisite degree of particularity, any significant aspect of its "computer software for business management, namely, for managing and coordinating risk, time and financial parameters in multi-component business analysis and project development." To be sure, the record confirms that the terminology "business process re-engineering" is a well established term of art which has come to be regarded as essentially meaning the study of work flows for the purpose of getting business processes done more efficiently. We concur with applicant, however, that just because the word "industry" has been demonstrated to be a synonym for the term "business," that does not mean that the phrase "industry process re-engineering" has the same connotation as the phrase "business process re-engineering." In fact, the record shows that, at the present time, there is no definitive or well-known meaning for the former, unlike the case with the latter. Moreover, even if such phrases had been shown to be identical in meaning or even substantially so, it is not at all clear that applicant's goods, as identified, may fairly be said to encompass business process re-engineering software. Furthermore, the record indicates, as noted previously, that the phrase "industry process re-

engineering," while a term which has some significance and is not unknown in the business field, is too ambiguous or amorphous to immediately describe any particular characteristic, feature, use or purpose of applicant's goods. At most, with the aid of imagination and mature thought or a multi-step reasoning process, such phrase may tend to suggest, as the Internet excerpts relied upon by the Examining Attorney would seem to indicate, that "industry process re-engineering" is some sort of expansive or industry-wide form of business process re-engineering, but it is still not clear that applicant's software "is for the purpose of managing industry process re-engineering" and/or "performs the tasks of industry process re-engineering" as variously asserted by the Examining Attorney. In addition, it simply is not plain from the record that there is such a thing as "process re-engineering for industries," as the Examining Attorney claims, and that applicant's goods are thus "a software tool designed to assist in process re-engineering of industries."

Instead, on this record, we are left with doubt as to whether the phrase "INDUSTRY PROCESS RE-ENGINEERING" would convey forthwith, without conjecture or speculation, information about any significant attribute of applicant's software to customers and/or users thereof. In accordance with the Board's settled practice, we therefore resolve such doubt in favor of the publication of applicant's mark for opposition. See, e.g., In re Conductive Systems, Inc., 220 USPQ 84, 86 (TTAB 1983); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

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Decision: The refusal under Section 2(e)(1) is reversed.